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Name

Date

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Thomas R. Cech et al.

Art Unit: 1632

Filing Date: January 11, 2002

Examiner: Louis D. Lieto, Ph.D.

Serial No: 10/044,539

Docket: 015389-002630US; 018/212c

Title: MAMMALIAN CELLS THAT HAVE  
INCREASED PROLIFERATIVE CAPACITY

## APPEAL BRIEF

Commissioner for Patents  
Alexandria, VA 22313

Dear Sir,

Applicants hereby appeal from the final Office Action mailed May 6, 2005. This paper constitutes applicants' Appeal Brief, as required under 37 CFR § 41.37.

A Notice of Appeal was filed in this application on October 6, 2005, setting the deadline for filing an Appeal Brief to December 6, 2005. This Brief is accompanied by a Petition for a four-month extension of time, along with authorization to charge the Deposit Account with the requisite fees, setting the due date to April 6, 2005. Accordingly, this paper is timely filed.

The Board of Patent Appeals and Interferences is respectfully requested to reverse rejection of the claims and allow the patent to issue, in view of the following remarks.

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STATEMENTS PURSUANT TO 37 CFR § 1.192

Real Party in Interest

The real party in interest for the claimed invention is Geron Corporation, a Delaware corporation, and the Regents of the University of Colorado, to which the application and the claimed invention has been assigned in their entirety.

Related Appeals and Interferences

No other appeals or interferences are known by applicants or their representative that would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of claims

- Claims 1-33: Under examination: Rejected for obviousness-type double patenting
- Claims 34-35: Cancelled
- Claims 36-38: Under examination: Rejected for obviousness-type double patenting

Status of amendments

All amendments to the claims have been entered. No amendments were filed after the last final Office Action.

Summary of claimed subject matter

This application claims an isolated mammalian cell transfected to express a nucleic acid sequence that encodes a telomerase reverse transcriptase protein based on the human TRT sequence or a close homolog or fragment thereof. As a result of the TRT expression, the cells have increased proliferative capacity, which is of benefit to the skilled user in the use of such cells for several different commercial purposes. The prototype TRT nucleic acid sequence disclosed in this application (SEQ. ID NO:1), and consequently the use of this sequence for purposes of increasing proliferative capacity of a cell, is new and inventive over the prior art.

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Grounds of rejection to be reviewed on appeal

Claims 1-33 and 36-38 stand rejected under the doctrine of obviousness-type double patenting with respect to issued U.S. Patent Nos. 6,261,836 and 6,337,200, and with respect to pending U.S. application 09/721,477.

ARGUMENT

The pending claims stand rejected for obviousness-type double patenting with respect to U.S. Patent No. 6,261,836, U.S. Patent No. 6,337,200, and USSN 09/721,477.

The 09/721,477 application is less advanced in prosecution than the present case. Whether or not the subject matter is overlapping, the question of double patenting in the present application does not arise since the cited application has not yet issued as a patent.

The rejection in view of U.S. Patent 6,261,836 is acknowledged. Applicants undertake to file a Terminal Disclaimer or otherwise address this issue once the Office indicates that the application is otherwise in condition for allowance.

Applicants respectfully disagree with the double patenting rejection with respect to claims 1, 10, and 11 U.S. Patent 6,337,200. The 6,337,200 patent claims telomerase reverse transcriptase (TRT) variants and TRT transfected cells that are patentably distinct over the present disclosure.

Claim 1 of the cited patent does not raise double patenting issues, because it claims TRT nucleic acids, which do not overlap with an isolated mammalian cell comprising a recombinant polynucleotide containing a nucleic acid sequence that encodes a telomerase reverse transcriptase protein having telomerase catalytic activity when complexed with a telomerase RNA.

The invention embodied in claims 10 and 11 of the cited patent cover cells that contain TRT variants that are a special subset of the TRT described in the present disclosure. The special subset has been found patentable over the disclosure to which the present application claims priority (USSN 08/854,050, now U.S. Patent 6,261,836). It therefore represents a particular embodiment or "improvement" that will be of interest to the skilled reader for particular uses. The inventorship and ownership of the 6,337,200 patent are different from that of the present application. Indeed, if the 6,337,200 patent was invented by an entirely independent laboratory, then no double patenting rejection would be made. Surely it is unfair to the owners of the invention claimed here to be subject

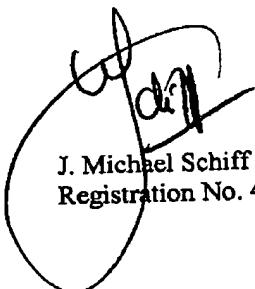
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to the complications of a double patenting rejection over what constitutes a subsequent improvement patent, simply because the 6,337,200 patent and the present application share a single coinventor.

Applicant respectfully requests that rejection of all claims under examination be reversed.

Should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicant hereby petitions for such relief, and authorizes the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,



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April 6, 2006

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